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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/300,881	04/28/99	WOLFSTON J	P-01757-US1

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TM02/1022

EXAMINER	
FISCHER, A	
ART UNIT	PAPER NUMBER
2167	

DATE MAILED: 10/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/300,881	James H. Wolfston
Examiner	**Art Unit**
Andrew J. Fischer	2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Sep 27, 2001* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above, claim(s) *1-5* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *6-20* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

Election/Restriction

1. Applicant's election of Group II (claims 6-20) in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 1-5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 9.

Claim Objections

3. Claim 8 is objected to because of the following informalities: the claim does not end with a period. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not produce a tangible result. See *In re Warmerdam*, 33 F3d 1354, 31 USPQ2d 1754 (Fed Cir 1994). Applicant recites the program

executes on the computer "to" do something and not that the program actually does the intended task.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow:

a. In claim 13, the term "donation level" is indefinite since it may comprise a single donation, multiple donations, or based upon a personal level of the donor.

b. In claim 14, it is unclear if "category" in the "publishing donations totals by category" is the same or different from the "categories" in "totaling donations categories ...."

c. In claim 15, the term "competing groups of donors" is indefinite since there is no way to distinguish competing groups from non competing groups. All donors may compete at one time and may not compete some time later.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 6-8, 10, 12-15, 17, 18, and 20, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Molbak et. al. (U.S. 5,909,794). Molbak et. al. discloses the claimed method and apparatus including a network server (central computer 114), the system automatically accepts donations (the computer system accepts donations via the computer without an intake person); the system automatically publishes the information about the donor (the info is published to the system daily); the donation list (name and amount) is published on the network; publishing the donation totals by category (inherent, category being the charitable organization); the donors are competing groups since they may be endowments; and the published list is ordered (inherent: either alphabetically, by amount, by organization, or by date).

10. Claims 6-8, 10, 12-15, 17, 18, and 20, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Ziarno (U.S. 6,253,998 B1). Ziarno discloses the claimed method and apparatus including a fund raising system with a server (inherent); the donations are automatically accepted (a computer accepts the donations) and published.

11. Functional recitation(s) using the word "for" (e.g. "for communicating with individuals over a computer network" as recited in claim 17) have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

12. It is the Examiner's position that because the terms "publish" and "publishing" are not explicitly defined in Applicant's specification, the terms are interpreted as having their ordinary and accustomed meaning.

13. Furthermore, the Examiners take Official Notice that publicly publishing donor information is old and well known art.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ziarno. Ziarno discloses as discussed above and does not directly disclose indicating which information would be published. The Examiner takes Official Notice that its very old and well know for non-profit agencies to indicate to their donors information that would be publicly available (e.g. names) and which information would not be publicly available (e.g. credit card numbers).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ziarno to include indicating which parts of the information is to be published. Such a modification would notify donors of common industry standard practices.

16. Claims 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ziarno in view of Herr-Hoyman et. al. (U.S. 5,727,156). Ziarno discloses as discussed above and does not directly disclose providing a link to an electronic webpage for information about the donor. Herr-Hoyman et. al. teaches an automatic publishing system which publishes hypertext documents. The link may be an email address, or other links to an online phone directory.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ziarno as taught by Herr-Hoyman et. al. to include providing a link to a electronic webpage. Such a modification would have allowed users to contact donors with having to re-type their email address since merely double-clicking would enter the email mode.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Burke (U.S. 6,112,191); Zervides et. al. (U.S. 6,052,674); Picard et. al. (U.S. 5,940,834); Burke (U.S. 5,621,640); Hovakimian (U.S. 5,466,919); and Smith et. al. (U.S. 5,111,395).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.

10/15/01

ROBERT P. OLSZEWSKI
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PATENT EXAMINER

AJF
October 11, 2001